

REMARKS

Applicants have submitted this Amendment and Response in reply to the outstanding Final Official Action date July 31, 2006 and Applicants believe that the Amendment and Response is fully responsive to the Final Official Action for at least the reasons set forth herein.

Applicants note that Claims 4 and 7 have been amended herewith. Claims 4 and 7 have been amended to recite, *inter alia*, an oscillator for generating a clock signal having a preset frequency, the oscillator is provided in a camera control unit to which the endoscope is removably connected. The amendment is presented to clarify the location of the oscillator. Additionally, Claim 6 has been amended to correct a minor typographical error. Such amendment is neither a narrowing amendment nor substantially related to patentability. No new matter has been added to the application by way of the aforementioned amendments. For example, Applicants direct the Examiner's attention to Figure 3 and its corresponding description in the specification.

Applicants respectfully submit that Claims 4-9 are patentably distinct from the cited references. Applicant further submits that the unamended claims were patentable over the cited references.

Claims 4-9 stand rejected under 35 U.S.C. §103 (a) as being unpatentable over U.S. Patent No. 5,196,928 to Karasawa in view of U.S. Patent No. 5,255,092 to Loonen in further view of Saegar, U.S. Patent 5,287,188.

Applicants respectfully disagree with the Examiner's rejection and traverse with at least the following analysis.

Independent Claims 4 and 7 recite that the drive circuit and the frequency dividing circuit are located **in the endoscope**. In the instant application, Figure 3 clearly illustrates that the

frequency driving circuit 132 is located in the endoscope. In stark contrast, in Karasawa the driving circuit is clearly located in the video processor. See Figure 2. The CCD is provided with a drive signal sent from a drive circuit 25a in an image processing unit of a video processor. See Col. 3., lines, 43-45. See also Col. 6 (“When a drive signal originating from a CCD drive circuit 25a in an image processing unit 25 is applied to the CCD 24b, image data is input . . .”). Therefore, Karasawa does not teach the claimed configuration.

Saegar and Loonen fail to cure this deficiency.

All three prior art references will have the same problem as the conventional art, i.e., the problem that this invention is solving. There is simply no disclosure or suggestion of Applicants' invention, which can accommodate different types of CCDs driven at different frequencies. In particular, clock conversion is performed in the line memory so that only one type of clock signal processing need be performed within the camera control unit CCU. A single oscillator located in the CCU can control different types of CCDs. Therefore, the claimed invention is capable of performing the signal processing with one type of clock for a plurality of types of CCDs.

Additionally, Applicants submit that there is no motivation to combine Loonen with Karasawa. It has been held by the courts that to establish *prima facie* obviousness, there must be some suggestion or motivation to combine and/or modify the reference. See *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). The absence of such a suggestion to combine is dispositive in an obviousness determination. See *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997). “The showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence.” Teleflex, Inc. v. Ficosa North American Corp., 299 F.3d 1313, 63 USPQ2d 1374

(Fed. Cir. 2002) (citing *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)).

There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). The motivation can come from the nature of the problem, the reference, or common knowledge. *Id.* The Federal Circuit stated:

[V]irtually all [inventions] are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. The Board [of Appeals] did not, however, explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. ... To counter this potential weakness in the obviousness construct the suggestion to combine [modify] requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.

In re Rouffet, 47 USPQ2d 1457-58 (Fed. Cir. 1998) (citations omitted, emphasis added).

That the combination of references *would result* in a claimed invention is only part of the 35 U.S.C. § 103 analysis, the Examiner must also show a motivation or suggestion for modifying the references; this the Examiner has not done. Such conclusory statements are insufficient to

show a motivation or suggestion to modify the references. Ecolochem, Inc. v. Southern California Edison Co., 227 F.3d 1361, 1372, 56 USPQ2d 1065, 1073 (Fed. Cir. 2000).

Additionally, the mere fact the reference can be combined or modified does not render the resultant combination obvious. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art reference "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." Id. at 682.

In the outstanding Final Official Action, the Examiner avers that Loonen teaches that the reading signal has a higher frequency than the write signal. Applicants submit that the Examiner's assertion that the feature was provided to alleviate the problem of accurate clock is false.

It appears that the Examiner is taking statements from the reference out of context. Loonen describes in the summary of the invention that:

[i]t is an object of the invention to provide a television pick-up and/or display device of the kind set forth in which a clock frequency can be accurately adjusted and in which the clock signal has a fixed phase with respect to a reference signal, notably a line synchronizing signal.

To achieve this, a pick-up and/or display device in accordance with the invention is characterized in that the clock comprises an oscillator having an adjustable frequency for supply of an output signal to the memory and to an integrating comparator circuit which is suitable to produce an output signal variation which is proportional to a difference between a mean input signal and a predetermined reference voltage for supply to a frequency set input of the oscillator, the oscillator has a trigger input which is coupled to the synchronizing pulse generator in order to switch the oscillator on and off.

Col. 1 lines 50-68.

Curiously, this section does not mention frequencies of the read and write signal. The features that achieve the accurate clock are the circuit configurations described in Col. 1, lines 57-Col. 2, lines 9.

Accordingly, there is no motivation to combine Loonen with Karasawa.

Furthermore, Applicant submits that there is no motivation to combine Saeger with either Loonen and Karasawa. Once again, while Saeger briefly mentions a frequency dividing circuit, which divides the clock signal to generate a signal for the drive circuit, the reference does not teach that this feature is specifically provided for alleviating the problems associated with changing display ratios. In fact, Saeger barely even addresses or mentions the frequency dividing circuit.

Pro arguendo, even if there is a motivation to combine the references, none of the references teach that the writing signal generating circuit generates the writing signal based on the signal generated by the frequency dividing circuit as claimed. Saeger only teaches using the frequency dividing circuit for the drive signal. In other words, none of the references teach using the same frequency dividing circuit for both the driving signal and the writing signal.

Therefore, Applicants submit that the hypothetical combination of the cited references fail to teach, suggest or render obvious, each and every limitation of independent Claims 4 and 7.

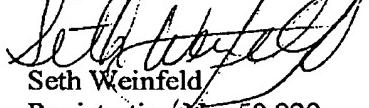
Applicants submit that Claims 5, 6, 8 and 9 are patentable based upon their dependency from Claims 4 and 7, respectively, in view of at least the above-identified analysis.

For all the foregoing reasons, the Applicants respectfully request the Examiner to withdraw the rejection of Claims 4-9 pursuant to 35 U.S.C. § 103(a).

In conclusion, the Applicants believe that the above-identified application is in condition for allowance and henceforth respectfully solicits the Examiner to allow the application. If the

Examiner believes a telephone conference might expedite the allowance of this application, the Applicants respectfully request that the Examiner call the undersigned, Applicants' attorney, at the following telephone number: (516) 742-4343.

Respectfully submitted,



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